

**RECEIVED  
CENTRAL FAX CENTER**

Appl. No. 09/558,925

**JUL 13 2006****REMARKS**

Claims 31-41, 50, 52-55, and 60-77 are pending in the present application. No claims are added or cancelled hereby. The remarks below support applicant's assertion that these claims are statutory and distinguish over the prior art, and are therefore in condition for allowance.

**35 U.S.C. § 101**

Initially, in the Office Action, claims 70-75 were rejected under 35 USC 101 as not producing a "useful, concrete and tangible result." Claims 70-75 have been amended herein to address the rejection under 35 U.S.C. 101. They are now directed to a computer-readable storage medium having stored thereon a number of functional software objects. As such, the claim is directed to "functional descriptive material" (as defined by MPEP 2106) recorded on a computer-readable medium. As stated in MPEP 2106, "[w]hen functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized." Thus, claims 70-75 as amended satisfy the requirements of 35 U.S.C. 101.

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35 U.S.C. § 103

Claims 31-77 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Furst (USP 6,297,819). Applicant respectfully traverses this rejection as detailed below.

As a very brief reminder, the present invention is directed to a method of rendering internet content in a unique frame (collectively referred to as a NIM), for example on a user's display. The frame has a format, and includes controls, which are designed to relate to the content as determined by the frame provider (i.e., specific to the content). While the content is capable of being read by an internet browser application, both the frame and the content are actually rendered independent of a web browser application. In terms of the specification, this is illustrated for example at page 20, line 18, which states that "... the content of the NIM is not trapped in a third party viewer." That is, the content need not be within or tied in any way to a web browser window. As a further example, page 33, lines 17-18 of the specification states that "[t]he definition of a NIM thus includes everything that is needed for the NIM to be rendered and filled with Internet content," i.e., nothing from or associated with a web browser application is needed. (See also, for example, Figs. 9A and 9B which illustrate a number of NIMs, showing them completely outside of and disconnected from any sort of web browser application window.) This independence from a web browser application frees the content provider from the constraints on presentation of content imposed by traditional web browser software and user interfaces.

An example of a frame having a format, and including controls, which are designed to relate to the content as determined by the frame provider (i.e., specific to the content) is a frame designed to provide a visual indication of the weather, such as a sun for a sunny day, a sun behind clouds for a partly cloudy day, etc., each visual illustration being designed or selected by

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the frame provider, and which include a control for selecting the region for which the weather is indicated. Selection of the appropriate content or image for the frame is based on data provided either by the frame provider, or by a third party. Another example is a frame representing a clock face to indicate the time, a control being provided to allow a user to select from among several different styles or designs for the clock face, each design or style being designed or selected by the frame provider.

Applicant makes the following two points in the discussion supporting its traversal of the rejection of claims 31-77:

- (1) The rendering of Furst's "tools" as freeform graphics with enclosing boxes or window decorations, and updating the tools with information generated by application programs would not suggest to one skilled in the art that a frame and content could be rendered independently from a web browser program, and
- (2) Therefore, Furst does not teach or suggest "the frame and first Internet content rendered independently from a Web browser program" (claim 31, lines 7-8).

Fundamentally, applicant asserts that the Furst reference does not teach or suggest that frame and content be rendered independently from a Web browser program. Applicant has previously made this argument. At paragraph 6, the Office Action states that:

Furst does not explicitly state that the frame and content are rendered independently from a web browser program, however, Furst does disclose that the elements can take other forms, such as free-form graphics without enclosing boxes or window decorations and that the tool windows are updated by the tools with the information generated by the application programs (col. 8, lines 15-25, 40-45). This would

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indicate to one of ordinary skill in the art that the tool is independent of the browser window.

The Office Action addresses applicant's prior argument that the Furst reference does not teach or suggest that frame or content be rendered independently from a Web browser program by stating that the sections cited in the preceding extracted portion of the Office Action would indicate to one of ordinary skill in the art that the Web browser program would have absolutely nothing to do with rendering the frame. While applicant respects the rationale offered in the Office Action, that rationale is not correct.

With respect to Furst, column 8, lines 39-46, applicant asserts that the form of the tool, and whether or not it includes an enclosing box or window decoration is irrelevant. The only non-window example of a tool illustrated by Furst is found in Fig. 5, the figure cited as an example of the very section cited by the Office Action. In Fig. 5 the tools are shown connected to a browser window. In further support of this, note that the tools are shown to "span the scroll bar of the current web browser window" (column 8, lines 45-46, emphasis added). That is, a web browser must be open for the tools to have any context.

With respect to Furst, column 8, lines 15-20, applicant asserts that the phrase "the active tools will be updated with information generated by (or at the request of) the application programs running on the tool servers" does not teach that the tools are rendered independently of a web browser. Rather, it merely states that the content displayed by the tools can be provided by other application programs - the tools themselves are rendered dependent upon a web browser program (for example, the site being browsed).

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Importantly, the very sentence cited against the claims and referred to above begins "[a]s the user navigates the web using the web browser and the context changes..." (col. 8, lines 16-17, emphasis added). The Patent Office cannot without a suggested motivation in the reference pick and choose certain features and disregard others. "[T]he examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references ... in the manner claimed." In re Rouffet, 149 F.3d 1350, 1357 (Fed. Cir. 1998). Absent such a suggestion, all of the teachings of the reference must be considered as a whole. Otherwise, a modification of the cited reference is being proposed, in which case the burden is on the Patent Office to explain how the prior art suggests and motivates the proposed modification so as to render obvious the claimed invention. Ex parte Levy, 17 U.S.P.Q.2d 1461 (BPAI 1990). No suggestion or motivation to separate tools from web browser has been identified in the Office Action, and applicant asserts that there is no such suggestion or modification in Furst.

In fact, as Furst is replete with references to and illustrations of the dependence of the rendering of the tools on a web browser, to do without the web browser becomes a significant modification to the fundamental operating principles of the invention claimed in that patent. As a matter of law, such a significant modification precludes a finding of obviousness. "If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)." M.P.E.P. § 2143.02.

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Accordingly, applicant has demonstrated that the Furst patent does not teach or suggest:

that "the frame and first Internet content [be] rendered independently from a Web browser program" (claim 31, lines 7-8, emphasis added)

"the user interface and content data presented independently from a Web browser program" (claim 50, lines 6-7, emphasis added)

"displaying independently from a Web browser program the user interface with which a visual manifestation of the content data is presented" (claim 62, lines 7-8, emphasis added)

"said frame further rendered independent of a Web browser program" (claim 70, lines 7-8, emphasis added), nor

"the frame and first Internet content rendered independently from a Web browser program" (claim 76, lines 9-10, emphasis added).

"To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." M.P.E.P. § 2143.03. Accord. M.P.E.P. § 706.02(j). As the limitation "rendered independently from a Web browser program" is not found in Furst, no *prima facie* case of obviousness has been established with regard to claims 31, 50, 62, 70 or 76.

Each of the remaining claims in the present application depends, directly or indirectly, on one of claims 31, 50, 62, 70 or 76, and therefore contains all limitations of the claim on which it depends. As the Furst reference fails to teach all elements of claims 31, 50, 62, 70 and 76 and

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thus fails to render those claims *prima facie* obvious, for the same reasons Furst also fails to teach all elements of the remaining dependent claims, and thus fails to render those claims *prima facie* obvious.

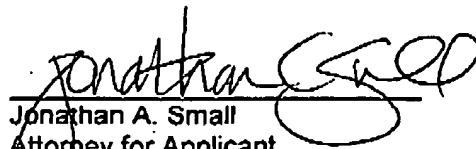
### Conclusion

For the foregoing reasons, the present application is thought to be clearly in condition for allowance. Accordingly, favorable reconsideration and issuance of a formal Notice of Allowance for this application in light of the amendments and remarks provided above is respectfully requested.

By action taken here, Applicant in no way intends to or causes any surrender of any subject matter or range of equivalents beyond that strictly required to patentably distinguish the claimed invention as a whole over the prior art. Applicant expressly reserves without dedication all such subject matter and equivalents that may fall in the range between Applicant's literal claim recitations and the scope of the prior art.

If the Examiner believes that a telephone conference would expedite prosecution and allowance of this application, please telephone the undersigned at 650-941-4470.

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